



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicants : Ganapathy Krishnan et al.
Application No. : 10/770,353
Filed : February 2, 2004
For : Method and System for Securely Incorporating Electronic
Information into an Online Purchasing Application
Examiner : John M. Winter
Art Unit : 3621
Docket No. : 35040.001C4
Date : June 13, 2008

APPEAL BRIEF

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Sir:

This appeal is from the decision of the Examiner, in an Office Action mailed December 13, 2007, rejecting claims 1-20 and 22-30.

REAL PARTY IN INTEREST

The real party in interest is CRS LLC a Washington Limited Liability Company having a principal place of business at 2800 One Union Square, 600 University Street, Seattle, WA 98101

RELATED APPEALS AND INTERFERENCES

Applicant's representative has not identified, and does not know of, any other appeals of interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Applicants' appeal the final rejection of claims 29-57 in the Office Action dated March 9, 2007, and a subsequent rejection of the claims in an Office Action dated December 13, 2007, which are copied in the attached CLAIMS APPENDIX.

STATUS OF AMENDMENTS

An Amendment After Final was enclosed with the originally filed appeal brief of August 9, 2007, and is again enclosed with the current appeal brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 29

Claim 29 is directed to a system for acquiring digital content (Current Application, page 7, line 14 - page 8, line 21). The system includes: (1) a digital-content-accessing component (304 in Figure 3) invoked by a selection interface (303 in Figure 3; page 13, line 29 - page 14, line 1), provided by a digital-content supplier (306 in Figure 3), to receive and authenticate one or more components of the digital content (Current Application, page 15, lines 25-28) on a client computer (311 in Figure 3), and to store the one or more received and authenticated components in an unusable form on the client computer (Current Application, page 15, line 28 - page 16, line 2 and page 17, lines 5-8); and (2) a license component incorporated within a component of the digital content that communicates with a remote licensing broker (307 in Figure 3) to verify that a user is licensed to receive the digital content and that generates a useable form of the digital content from the one or more components of the digital content (Current Application, page 16, lines 23-29).

Dependent Claims 30-41

Claim 30 is directed to the system of claim 29 wherein the selection interface

(303 in Figure 3; page 13, line 29 - page 14, line 1) is instantiated on the client computer, wherein the selection interface provides a description of the digital content; and wherein the selection interface provides for selection, by the user, of the digital content for acquisition from a remote digital-content vendor (Current Application, page 16, lines 17-21). Claim 31 is directed to the system of claim 30 wherein the selection interface (303 in Figure 3; page 13, line 29 - page 14, line 1) is one of: (1) an executable file that displays a graphical user interface; (2) data received by the client computer that is rendered by a program running on the client computer to display a graphical user interface; (3) a web page displayed by a browser application running on the client computer; (4) a text file stored on the client computer that includes links or references to the digital content that allow the user to access the digital content by a communications means including one or more of an Internet browser; email; mail; telephone; fax; and file transfer protocols. Claim 32 is directed to the system of claim 29 wherein the digital-content-accessing component (304 in Figure 3) is an executable file that, when executed on the client computer, accesses and receives the components of the digital content from remote computer systems. Claim 33 is directed to the system of claim 32 wherein the digital-content-accessing component (304 in Figure 3) is transmitted from a remote computer to the client computer through a communications medium. Claim 34 is directed to the system of claim 32 wherein the digital-content-accessing component (304 in Figure 3) is generated locally on the client computer from a component list. Claim 35 is directed to the system of claim 29 wherein the digital-content-accessing component (304 in Figure 3) authenticates a received digital-content component by generating a message digest from the received digital-content component and comparing the generated message digest with a stored message digest. Claim 36 is directed to the system of claim 29 wherein at least one received digital-content component is encrypted (Current Application, page 8, lines 8-11). Claim 37 is directed to the system of claim 29 wherein the license component requests an electronic license certificate from the licensing broker (Current Application, page 16, lines 15-16). Claim 38 is directed to the system of claim 37 wherein, when the license component (307 in Figure 3) receives an electronic license certificate from the licensing broker, the license component decrypts any encrypted, received digital-content components. Claim 39 is directed to the system of claim 29 wherein the license component executes a purchase transaction to purchase a license for the digital content on behalf of the user (Current Application, page 16, lines 15-23). Claim 40 is directed to the system of claim 29 wherein components of the digital content (Current Application, page 6, lines 25-28 and page 12, line

16 - page 13, line 3) may include one or more of: an encrypted executable file; an encrypted data file; a user interface library; a purchasing request library; a security information file; and an electronic license certificate. Claim 41 is directed to the system of claim 29 wherein digital content includes one or more of: digitally encoded executable code; digitally encoded source code; a digitally encoded video program; a digitally encoded audio program; digitally encoded music; a digitally encoded game; a digitally encoded multi-media program; a digitally encoded movie; and a digitally encoded text document (Current Application, page 11, lines 17-21).

Independent Claim 42

Claim 42 is directed to a system for supplying digital content by a digital-content supplier (Current Application, page 7, line 14 - page 8, line 21). The system includes: (1) a server that provides a selection interface (303 in Figure 3; page 13, line 29 - page 14, line 1) to a requesting client computer (311 in Figure 3); (2) one or more servers that provide, to a requesting digital-content-accessing component running on the client computer, components of the digital content in at least one of which a license component is incorporated (Current Application, page 15, lines 25-28); and (3) a means for providing license information to a remote licensing broker (307 in Figure 3) to license the digital content.

Dependent Claims 43-50

Claim 43 is directed to the system of claim 42 wherein the selection interface (303 in Figure 3; page 13, line 29 - page 14, line 1) is instantiated on the client computer, wherein the selection interface provides a description of the digital content; and wherein the selection interface provides for selection, by a user, of the digital content for acquisition from a remote digital-content vendor (Current Application, page 16, lines 17-21). Claim 44 is directed to the system of claim 42 wherein the selection interface (303 in Figure 3; page 13, line 29 - page 14, line 1) is one of: (1) an executable file that displays a graphical user interface; (2) data received by the client computer that is rendered by a program running on the client computer to display a graphical user interface; (3) a web page displayed by a browser application running on the client computer; (4) a text file stored on the client computer that includes links or references to the digital content that allow a user to access the digital content by a communications means including one or more of an Internet browser, email, mail, telephone, fax, and file transfer protocols. Claim 45 is directed to the system of

claim 42 wherein the digital-content-accessing component (304 in Figure 3) is an executable file that, when executed on the client computer, receives the components of the digital content from the digital-content supplier. Claim 46 is directed to the system of claim 45 wherein the digital-content-accessing component (304 in Figure 3) is transmitted by the digital-content supplier to the client computer. Claim 47 is directed to the system of claim 45 wherein the digital-content-accessing component (304 in Figure 3) is generated locally on the client computer from a component list supplied by the digital-content supplier. Claim 48 is directed to the system of claim 29 wherein at least one received digital-content component is encrypted (Current Application, page 8, lines 8-11). Claim 49 is directed to the system of claim 29 wherein components of the digital content (Current Application, page 6, lines 25-28 and page 12, line 16 - page 13, line 3) may include one or more of: an encrypted executable file; an encrypted data file; a user interface library; a purchasing request library; a security information file; and an electronic license certificate. Claim 50 is directed to the system of claim 29 wherein digital content includes one or more of: digitally encoded executable code; digitally encoded source code; a digitally encoded video program; a digitally encoded audio program; digitally encoded music; a digitally encoded game; a digitally encoded multi-media program; a digitally encoded movie; and a digitally encoded text document (Current Application, page 11, lines 17-21).

Independent Claim 51

Claim 51 is directed to a system for licensing digital content (Current Application, page 7, line 14 - page 8, line 21). The system includes a licensing server (307 in Figure 3) that receives and stores license information from a remote digital-content supplier, that generates an electronic license certificate for the digital content, and that provides the electronic license certificate for the digital content to a requesting license component running on a client computer that, upon receiving the electronic license certificate, generates a useable form of the digital content on the client computer from the one or more digital-content components received from the remote digital-content supplier (Current Application, page 16, lines 23-29).

Dependent Claims 52-57

Claim 52 is directed to the system of claim 51 wherein at least one digital-content component is encrypted (Current Application, page 7, lines 9-16). Claim 53 is

directed to the system of claim 51 wherein the license component requests an electronic license certificate from the licensing server (Current Application, page 8, lines 8-12). Claim 54 is directed to the system of claim 53 wherein, when the license component receives an electronic license certificate from the licensing server, the license component decrypts any encrypted, digital-content components (Current Application, page 8, lines 13-17). Claim 55 is directed to the system of claim 51 wherein the license component executes a purchase transaction to purchase a license for the digital content on behalf of a user (Current Application, page 12, lines 6-8). Claim 56 is directed to the system of claim 51 wherein digital-content components may include one or more of: an encrypted executable file; an encrypted data file; a user interface library; a purchasing request library; a security information file; and an electronic license certificate (Current Application, page 6, lines 25-28 and page 12, line 16 - page 13, line 3). Claim 57 is directed to the system of claim 51 wherein digital content includes one or more of: digitally encoded executable code; digitally encoded source code; a digitally encoded video program; a digitally encoded audio program; digitally encoded music; a digitally encoded game; a digitally encoded multi-media program; a digitally encoded movie; and a digitally encoded text document (Current Application, page 11, lines 17-21).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. The rejections of claims 29-57 under 35 U.S.C. § 112.
2. The rejection of claims 29-57 under 35 U.S.C. § 103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624 ("Katz") in view of Coley et al., U.S. Patent No. 5,790,664 ("Coley").

ARGUMENT

Claims 29-57 are pending in the current application. In an office action dated September 11, 2006, the Examiner rejected all claims under 35 U.S.C. § 112, second paragraph, and rejected claims all claims under 35 U.S.C. § 103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624 ("Katz") in view of Coley et al., U.S. Patent No.

5,790,664 ("Coley"). There appeared to be a numbering inconsistency in the office actions and responses. The current claims were introduced by amendment on December 16, 2005. They were improperly numbered 1-20 and 22-30. They should have been numbered 29-57. Appellants' representative has therefore amended the claims, in an amendment after final that accompanied the originally filed appeal brief, of August 9, 2007, and which is again enclosed with the current appeal brief, to have proper numbering of 29-57.

In a final rejection dated March 9, 2007 ("Final Rejection"), the Examiner maintained the rejection of claims 29-57, but did not again mention the 35 U.S.C. § 112, second paragraph rejections. Appellants' representative therefore traversed the 35 U.S.C. § 103(a) rejections of claims 29-57 in the originally filed appeal brief of August 9, 2007. The Examiner then reopened prosecution, and issued an office action dated Dec. 13, 2007 ("Office Action"), in which the Examiner again reasserted the 35 U.S.C. § 112 rejections and reasserted 35 U.S.C. § 103(a) rejections of claims 29-57 identical to those previously asserted.

On page 2 of the Office Action, the Examiner states:

The Applicants [sic] amendment filed on September 11, 2007 is hereby acknowledged, [sic] Claims 1-10, 22-30 remain pending. Applicant's [sic] request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of the action is withdrawn.

Although Appellants' representative is grateful to have been deemed to produce something that was persuasive, particularly in view of the number of times Appellants' representative has been considered to not have been persuasive in responses to the USPTO, Appellants' representative does not understand this statement, nor does Appellants' representative understand why prosecution was reopened. In the originally filed appeal brief, Appellants traversed the rejection of the current claims, and not simply the finality of the claim rejections. Appellants did not file an amendment on September 11, 2007, but instead filed an appeal brief on August 9, 2007 along with an amendment after final to correct claim numbering. That amendment after final has not been acknowledged by the Examiner, and so Appellants again enclose that amendment after final with the current appeal brief in order to correct claim numbering. The Examiner has appeared to issue claim rejections identical to those made in the office action of March 9, 2007, and therefore Appellants' representative can see no point in returning to prosecution. Therefore, Appellants respectfully submit the

current appeal brief.

ISSUE 1

1. The rejection of claims 29-57 under 35 U.S.C. § 112.

Apart from quoting the first sentence of the second paragraph of 35 U.S.C. § 112, which neither mentions nor suggests anything at all related to "hybrid" claims, the Examiner has failed to cite any authority, whether statute, rule, or case law, for the rejections of the current claims as being "hybrid" claims. However, in M.P.E.P. § 2106 (IV) (B), the M.P.E.P. states, with emphasis added by Appellants' representative:

The scope of 35 U.S.C. 101 is the same regardless of the form or category of invention in which a particular claim is drafted. *AT&T*, 172 F.3d at 1357, 50 USPQ2d at 1451. See also *State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602 wherein the Federal Circuit explained:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter -- [provided the subject matter falls into at least one category of statutory subject matter] but rather on the essential characteristics of the subject matter, in particular, its practical utility.

For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter the claim belongs, does not affect the analysis to be performed by USPTO personnel. Note that an apparatus claim with process steps is not classified as a "hybrid" claim; instead, it is simply an apparatus claim including functional limitations. See, e.g., *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished).

This section of the M.P.E.P. would suggest that the Examiner's rejections lack any basis in rule or case law. Because the Examiner has cited no authority for the rejection, Appellants' representative believes the rejection to be unfounded and improper. Moreover, Appellants' representative cannot respond to such a rejection, either by argument or amendment, without understanding the basis for the rejections, if, in fact, there is a basis for the rejections.

ISSUE 2

1. The rejection of claims 29-57 under 35 U.S.C. § 103(a) as being unpatentable over Katz in view of Coley.

Appellants' representative first furnishes the arguments included in the originally filed appeal brief of August 9, 2007. Following those arguments, Appellants' representative provides additional observations, in a final subsection.

The Currently Claimed Invention

First, Applicants' representative briefly describes the three independent claims 29, 42, and 51. Independent claims 29, 42, and 51 are provided below, for the Examiner's convenience, with added emphasis:

29. A system for acquiring digital content, the system comprising:
a *digital-content-accessing component* invoked by a *selection interface*, provided by a *digital-content supplier*, to receive and authenticate one or more components of the digital content *on a client computer*, and to store the one or more received and authenticated components in an unusable form on the client computer; and
a *license component* incorporated within a component of the digital content that communicates with a remote *licensing broker* to verify that a user is licensed to receive the digital content and that generates a useable form of the digital content from the one or more components of the digital content.
42. A system for supplying digital content by a *digital-content supplier*, the system comprising:
a server that provides a *selection interface* to a requesting *client computer*;
one or more servers that provide, to a requesting digital-content-accessing component running on the client computer, components of the digital content in at least one of which a *license component* is incorporated; and
a means for providing license information to a remote *licensing broker* to license the digital content.
51. A system for licensing digital content, the system comprising:
a *licensing server*
that receives and stores license information from a remote *digital-content supplier*;
that generates an electronic license certificate for the digital content; and
that provides the electronic license certificate for the digital content to a requesting *license component* running *on a client computer* that, upon receiving the electronic license certificate, generates a useable form of the digital content on the client computer from the one or more digital-content components received from the remote digital-content supplier.

All three independent claims can be readily understood by reference to Figure 3 of the current application. As emphasized in the three independent claims, provided above, the claimed invention involves a selection interface (303 in Figure 3) that is displayed or otherwise instantiated on a client computer (311 in Figure 3) and that allows a user to select digital content provided by a digital-content supplier (306 in Figure 3) for acquisition by the user. The digital content is transmitted from the digital-content supplier (306) to the client computer (311), on request by digital-content-accessing component (304 in Figure 3) invoked by the selection interface, as one or more digital-content components and stored on the client computer in a form that is unusable by the user. When the user seeks to execute or render the digital content, a license component incorporated within a component of the digital content exchanges information with a license broker or license server (307 in Figure 3) to obtain a license for execution or rendering of the digital content. In certain embodiments of the present invention, a digital-content component is received by the digital-content-accessing component in an encrypted form that cannot be executed or rendered by the client computer. Upon receiving an electronic license certificate from the license broker (307), the license component decrypts the encrypted component or components, allowing the digital content to be executed or rendered on the client computer.

All three independent claims specifically mention the client computer, a remote digital-content supplier, and a remote license server or license broker that cooperate to provide digital content to a user in a way that prevents unauthorized execution or rendering of unlicensed digital content by a user that does not respect intellectual property rights. The license broker is a distinct and separate entity from the content supplier, and both the license broker and digital-content supplier are distinct and separate from the client computer. The above-provided independent claims also include additional elements, such as the digital-content-accessing component (404 in Figure 4, 507 in Figure 5, and Figure 8) and the license component (406 in Figure 4), and the independent claims and claims that depend from them further specify interrelationships between these additional elements and the client computer, the remote digital-content supplier, and the remote license server or license broker. For example, the digital-content-accessing component is either supplied by the digital-content supplier or generated from a component list supplied by the digital-content supplier. As another example, the selection interface is supplied by the digital content supplier.

In response to Applicants' traversal of the 35 U.S.C. § 103(a) rejections of the current claims, included in a response filed December 11, 2006, the Examiner states, on page 2 of the Final Rejection:

The Applicant states that the reference discloses by the Examiner fail to cite the claimed feature of cite of "a license component incorporated within a component of the digital content that communicates with a remote licensing broker to verify that the user is licensed to receive the digital content".

The Examiner responds that the applicant misinterprets the principle that claims are interpreted in the light of the specification. Although these elements of the licensing component interacting with a distinct remote licensing server are found as examples or embodiments in the specification, they were not claimed explicitly or were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. The Examiner contends that as claimed a "license component" could constitute merely a string of numbers etc ..., furthermore there is no language that explicitly states that the licensing broker is a distinct entity from the supplier etc ...

Applicants' representative respectfully submits that it is the Examiner, rather than Applicants, who has misinterpreted principles of claim interpretation.

As pointed out above, the specification clearly describes and illustrates each of: (1) a client computer; (2) a digital-content-accessing component; (3) a selection interface; (4) a license component; (5) a remote digital-content supplier; and (5) a remote license server or license broker. These components are described in the Summary of the Invention portion of the current application, again in the Detailed Description of the Invention section of the current application, and are illustrated in numerous figures. The claim terms must be interpreted in light of these descriptions, and not in view of arbitrary definitions suggested by the Examiner. For Example, in *Philips v. AWH*, decided on July 12, 2005 by the Federal Circuit, an extensive review of claim interpretation is provided, including:

We have frequently stated that the words of a claim "are generally given their ordinary and customary meaning." *Vitronics*, 90 F.3d at 1582 ... We have made clear, moreover, that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention ... Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. ... Because the meaning of a claim term as understood by persons of skill in the art is often not immediately apparent, and because patentees frequently use terms idiosyncratically, the court looks to "those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean." ... Quite apart from the written description and the prosecution history, the

claims themselves provide substantial guidance as to the meaning of particular claim terms. ... The claims, of course, do not stand alone. Rather, they are part of "a fully integrated written instrument," *Markman*, 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims "must be read in view of the specification, of which they are part." ... **On numerous occasions since then, we have affirmed that point, stating that "[t]he best source for understanding a technical term is the specification from which it arose ...** Consistent with that general principle, our cases recognize that the specification may reveal a special definition given to the claim term by the patentee that differs from the meaning it would otherwise possess. (emphasis added)

The Examiner contends: "as claimed, a 'license component' could constitute merely a string of numbers etc...., furthermore there is no language that explicitly states that the licensing broker is a distinct entity from the supplier etc..." The implementation of the license component is indeed not specified in the claims. Claims are not meant to be specifications or detailed blueprints of an invention. The licensing component is discussed, in great detail, in the current invention. A licensing component may be implemented as a software routine, and a naïve view of software - any software - is that it is merely a string of numbers, just as a telephone may be considered merely a hunk of plastic and metal, or a pharmaceutical may be considered merely a collection of low-atomic-number elements. The licensing component is clearly claimed, for example, in claim 29, as "a license component incorporated within a component of the digital content that communicates with a remote licensing broker to verify that a user is licensed to receive the digital content and that generates a useable form of the digital content from the one or more components of the digital content." The Examiner cannot ignore this claim language by dismissively suggesting that a licensing component is merely a string of numbers. Strings of numbers do not communicate with a remote licensing broker to verify that a user is licensed to receive the digital content, and do not generate a useable form of the digital content from the one or more components of the digital content. A software routine, executing on a client computer, that implements a license component, by contrast, may communicate with a remote licensing broker to verify that a user is licensed to receive the digital content, and do not generate a useable form of the digital content from the one or more components of the digital content. The licensing component is clearly discussed in the current application, which provides full support for the above-quoted claim language. The Examiner's attempt to discount or ignore that claim language based on describing the licensing component as merely a string of numbers is a clear error.

By rudimentary principles of claim interpretation, when two different phrases or terms are used in a claim, they are interpreted to refer to two different entities. Otherwise, claim language would be completely indefinite, and one would never know whether or not a claim referred to more than a single entity. Applicants' representative cannot remember ever reading a claim in which each element is introduced as being a distinct entity from all other, previously named elements in the claim. The suggestion by the Examiner that the licensing broker needs to be called out as being distinct from the digital-content supplier is absurd. The licensing broker and digital-content supplier are repeatedly described, in the current application, as being separate entities. For example, on lines 4 18 of page 13 of the Current Application, the separate nature of these components is discussed as being advantageous. The components are shown as separate entities in Figure 3. The components have quite different functionalities and purposes. There is no basis, in the specification or the claims, to conclude that the licensing broker is not a separate entity from the digital-content supplier. The attempt by the Examiner to combine two different claim elements of a claim into a single element, in order to read the claim onto a reference, is clear error.

Traversal of the Final Rejection of Claims 29-57 Under 35 U.S.C. § 103(a) as Being
Unpatentable Over Katz in View of Coley

For the sake of brevity, Applicants' representative discussed the rejection of claim 29, below, as representative of the claim rejections. The remaining independent claims 42 and 51 both include similar claim elements, and the dependent claims, of course, include the limitations of the independent claims from which they depend. As discussed in MPEP § 2142, to establish a prima facie case of obviousness, "the prior art reference (or references when combined) must teach or suggest all of the claim limitations." As discussed below, the Examiner has utterly failed to find a teaching or suggestion for almost all of the claim limitations of claim 29, and has similarly failed to find a teaching or suggestion for almost all of the claim limitations of the other independent claims 42 and 51 as well as all of the dependent claims.

In rejecting claim 29, on page 3 of the Final Rejection, the Examiner points only to Figure 2 of Katz for teaching the claim element: "a digital-content-accessing component invoked by a selection interface, provided by a digital-content supplier, to receive and authenticate one or more components of the digital content on a client computer." Figure 2 of Katz shows blocks representing: (1) a mobile playback device; (2) a client computer

system; (3) a distributable mass-storage medium; (4) a distribution network; and (5) a library server. Each of the blocks representing the mobile playback device, the client computer system, and the library server additionally include from 5 to 7 internal boxes representing internal components. The Examiner has failed to point to any specific feature or aspect of Figure 2 of Katz corresponding to: (1) a digital-content-accessing component invoked by a selection interface; (2) a digital-content supplier; and (3) reception and authentication of one or more components of the digital content on a client computer. In Applicants' representative's respectfully offered opinion, a rejection that requires Applicants to guess at the correspondence between three entities of a claim element and 25 separately labeled objects in figure provided in a reference is improper. Applicants' representative has no idea of what, in Figure 2 of Katz, corresponds to the claimed digital-content-accessing component. A client browser, for example, is not a digital-content-accessing component, because browsers do not "receive and authenticate one or more components of the digital content on a client computer." Moreover, nothing in Figure 2 teaches or suggests "a digital-content-accessing component invoked by a selection interface, provided by a digital-content supplier, to receive and authenticate one or more components of the digital content on a client computer."

In rejecting claim 29, the Examiner points only to Figure 5 of Katz for teaching the claim element: "to store the one or more received and authenticated components in an unusable form on the client computer." There is not a single teaching, suggestion, or mention in Figure 5 of Katz of "authenticated components in an unusable form" nor a teaching, mention, or suggestion of anything stored or received on a client computer. In Applicants' representative's respectfully offered opinion, a rejection based on only a Figure which does not teach, mention, or suggest the bulk of a claim element is baseless and improper.

In rejecting claim 29, the Examiner points to lines 1-14 of column 8 of Katz as teaching: "a license component incorporated within a component of the digital content that communicates with a remote licensing broker to verify that a user is licensed to receive the digital content." Lines 1-14 of column 8 of Katz mention content stored on a Library Server. There is no teaching, mention, or suggestion of "a license component," or communication "with a remote licensing broker to verify that a user is licensed to receive the digital content." There is nothing even remotely suggestive of any of the above-quoted language of claim 29 in lines 1-14 of column 8 of Katz. The rejection of this portion of claim 29 is simply absurd.

Please recall that the license component resides in digital content that is returned to a client computer, and that the license component communicates with a *remote license broker*. The referenced portion of Katz concerns only information stored on a Library Server.

Finally, in rejecting claim 29, the Examiner points to lines 41-48 of Coley as teaching "a license component incorporated within a component of the digital content that generates a useable form of the digital content from the one or more components of the digital content." The cited lines of Coley discuss a license server, remote from a client computer, that enables or disables a client application on a client computer. Nothing in this passage discusses generating "a useable form of the digital content from the one or more components of the digital content." Nothing in this passage teaches, mentions, or suggests "a license component incorporated within a component of the digital content." Again, the Examiner has cited a portion of a reference that does not teach, mention, or suggest the clearly claimed claim element against with the portion of the reference has been cited.

In summary, not one element of claim 29 is taught, suggested, or mentioned by the cited portions of Katz and Coley. Although Applicants could attempt to craft a claim rejection from Katz and Coley, it is not Applicants' job or obligation to do so. The Examiner has utterly failed in finding a teaching, mention, or suggestion for the elements of claim 29. The Examiner relies on similar arguments for rejection of independent claims 42 and 51, and those arguments fail for the same reasons as the above-discussed arguments with respect to claim 29 fail. Obviously, the Examiner has also failed to find a teaching, mention, or suggestion of all of the elements of none of the dependent claims, which necessarily include the elements of claims 29, 42, or 51, from which they depend, which the Examiner has failed to find a teaching, mention, or suggestion in the combination of Katz and Coley.

Additional Observations

While the recent U.S. Supreme Court decision, *KSR International Co. v. Teleflex Inc.* rejected the overly rigid and formalistic application of the Federal Circuit's teaching-suggestion-motivation ("TSM") test, as discussed in M.P.E.P. §2141(I), the *KSR* decision provided useful direction with regard to obviousness-type rejections. First of all, as discussed in M.P.E.P. §2141(II), *KSR* again emphasized that obviousness is a question of law based on underlying factual inquiries, including ascertaining the differences between the claimed invention and the prior art and resolving the level of ordinary skill in the pertinent art, and reemphasized the *Graham* factors. M.P.E.P. §2141(II) emphasizes the fact that

examiners, in making obviousness-type rejections, "fulfill the critical role of fact finder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual." Furthermore, in Appellant's representative's respectfully offered opinion, *KSR* clearly apportions significant responsibility and burdens on examiners, as discussed in M.P.E.P. §2141(III):

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The court quoting *In Re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed.Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

M.P.E.P. §2141(II), in emphasizing the fact that examiners, in making obviousness-type rejections, fulfill the critical role of fact finder, further states that: "Factual findings made by Office personnel are the necessary underpinnings to establish obviousness."

In rejecting claims 29, 42, and 51 (formerly claims 1, 14, and 24), the Examiner has again merely cited entire figures of Katz, without identifying particular objects or entities within those features that disclose the claimed subject matter. In Appellants' representative's respectfully offered opinion, for this reason alone, the 35 U.S.C. § 103(a) rejections of the current claims must fail, under the *KSR* standards. Appellants' representative can think of nothing more conclusory than referring to two entire figures, Figures 2 and 5 of Katz, which show "a high-level block diagram of the computer network based digital information library system" disclosed by Katz and "an alternative embodiment having a plurality of library servers," for the current claim element "a digital-content-accessing component invoked by a selection interface, provided by a digital-content supplier, to receive and authenticate one or more components of the digital content on a client computer, and to store the one or more received and authenticated components in an unusable form on the client computer." The figures merely show blocks. They do not disclose, by themselves, anything related to claim 29 (previously claim 1). The Examiner has not even undertaken a cursory attempt to map language of claim 29 onto the cited figures. By the *KSR* standard, the Examiner has failed the important fact-finding role, discussed above, and has completely failed to provide "articulated reasoning with some rational underpinning" in the rejection of the first element of claim 29 as being disclosed by Figures 2 and 5 of Katz. Furthermore, the

portion of Katz cited as disclosing the second element of claim 29, "a license component incorporated within a component of the digital content that communicates with a remote licensing broker to verify that a user is licensed to receive the digital content and that generates a useable form of the digital content from the one or more components of the digital content," contains no mention of any kind of "license component incorporated within a component of the digital content," but instead refers to converting digital content into digital information files and refers to an external library server executed on a remote computer system. Katz appears to be unrelated to the currently claimed invention, and the Examiner has failed to articulate any reason for asserting that Katz discloses anything at all related to claim 1. There is simply no rational underpinning provided by the Examiner, as required by KSR, for the 35 U.S.C. § 103(a) rejections of the current claims.

In addition, the Examiner states, on page 4 of the Office Action:

The Examiner notes that the features of "to receive and authenticate one or more components of the digital content on a client computer" and generates a useable form of the digital content from the one or more components of the digital content from the one or more components of the digital content" [sic] are directed towards intended usage of the system.

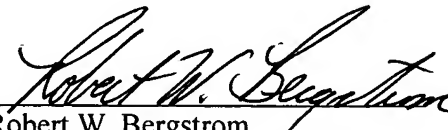
Again, the Examiner fails to cite any rule, statute, or case law to support employing this unfounded conclusion to reject claims 29, 42, and 51. For this reason alone, the rejection must fail, since the Examiner appears to be applying claim interpretation standards and principles created by the Examiner specifically for the instant case, rather than providing a proper foundation in rule, statute, or case law for the rejections. Appellants cannot respond to such rejections without understanding the regulatory, statutory, or legal basis on which the rejections are made. In the above statement, the Examiner has drawn an unwarranted and unsupportable conclusion, and then appears to have based, at least in part, the 35 U.S.C. § 103(a) rejections of claims 29, 42, and 51 on this unwarranted and unsupportable conclusion. Clearly, such rejections fall far short of the above-discussed *KSR* standards.

CONCLUSION

The Examiner has failed to point to any teaching, mention, or suggestion, in either Katz or Coley, for nearly all the claim elements of the current claims. Therefore, the 35 U.S.C. § 103(a) rejections of claims 29-57 are improper and baseless.

Appellants respectfully submit that all statutory requirements are met and that the present application is allowable over all the references of record. Therefore, Appellants respectfully requests that the present application be passed to issue.

Respectfully submitted,
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CLAIMS APPENDIX

1 – 28 Cancelled

29. A system for acquiring digital content, the system comprising:

a digital-content-accessing component invoked by a selection interface, provided by a digital-content supplier, to receive and authenticate one or more components of the digital content on a client computer, and to store the one or more received and authenticated components in an unusable form on the client computer; and

a license component incorporated within a component of the digital content that communicates with a remote licensing broker to verify that a user is licensed to receive the digital content and that generates a useable form of the digital content from the one or more components of the digital content.

30. The system of claim 29

wherein the selection interface is instantiated on the client computer,
wherein the selection interface provides a description of the digital content; and
wherein the selection interface provides for selection, by the user, of the digital content for acquisition from a remote digital-content vendor.

31. The system of claim 30 wherein the selection interface is one of:

an executable file that displays a graphical user interface;
data received by the client computer that is rendered by a program running on the client computer to display a graphical user interface;
a web page displayed by a browser application running on the client computer;
a text file stored on the client computer that includes links or references to the digital content that allow the user to access the digital content by a communications means including one or more of

an Internet browser,
email,
mail,
telephone,
fax, and

file transfer protocols.

32. The system of claim 29 wherein the digital-content-accessing component is an executable file that, when executed on the client computer, accesses and receives the components of the digital content from remote computer systems.
33. The system of claim 32 wherein the digital-content-accessing component is transmitted from a remote computer to the client computer through a communications medium.
34. The system of claim 32 wherein the digital-content-accessing component is generated locally on the client computer from a component list.
35. The system of claim 29 wherein the digital-content-accessing component authenticates a received digital-content component by generating a message digest from the received digital-content component and comparing the generated message digest with a stored message digest.
36. The system of claim 29 wherein at least one received digital-content component is encrypted.
37. The system of claim 29 wherein the license component requests an electronic license certificate from the licensing broker.
38. The system of claim 37 wherein, when the license component receives an electronic license certificate from the licensing broker, the license component decrypts any encrypted, received digital-content components.
39. The system of claim 29 wherein the license component executes a purchase transaction to purchase a license for the digital content on behalf of the user.
40. The system of claim 29 wherein components of the digital content may include one or more of:
- an encrypted executable file;

- an encrypted data file;
- a user interface library;
- a purchasing request library;
- a security information file; and
- an electronic license certificate.

41. The system of claim 29 wherein digital content includes one or more of:

- digitally encoded executable code;
- digitally encoded source code;
- a digitally encoded video program;
- a digitally encoded audio program;
- digitally encoded music;
- a digitally encoded game;
- a digitally encoded multi-media program;
- a digitally encoded movie; and
- a digitally encoded text document.

42. A system for supplying digital content by a digital-content supplier, the system comprising:

- a server that provides a selection interface to a requesting client computer;
- one or more servers that provide, to a requesting digital-content-accessing component running on the client computer, components of the digital content in at least one of which a license component is incorporated; and
- a means for providing license information to a remote licensing broker to license the digital content.

43. The system of claim 42

- wherein the selection interface is instantiated on the client computer,
- wherein the selection interface provides a description of the digital content; and
- wherein the selection interface provides for selection, by a user, of the digital content for acquisition from a remote digital-content vendor.

44. The system of claim 42 wherein the selection interface is one of:

- an executable file that displays a graphical user interface;
- data received by the client computer that is rendered by a program running on the client computer to display a graphical user interface;
- a web page displayed by a browser application running on the client computer;
- a text file stored on the client computer that includes links or references to the digital content that allow a user to access the digital content by a communications means including one or more of

- an Internet browser,
- email,
- mail,
- telephone,
- fax, and
- file transfer protocols.

45. The system of claim 42 wherein the digital-content-accessing component is an executable file that, when executed on the client computer, receives the components of the digital content from the digital-content supplier.

46. The system of claim 45 wherein the digital-content-accessing component is transmitted by the digital-content supplier to the client computer..

47. The system of claim 45 wherein the digital-content-accessing component is generated locally on the client computer from a component list supplied by the digital-content supplier.

48. The system of claim 29 wherein at least one received digital-content component is encrypted.

49. The system of claim 29 wherein components of the digital content may include one or more of:

- an encrypted executable file;
- an encrypted data file;
- a user interface library;
- a purchasing request library;

a security information file; and
an electronic license certificate.

50. The system of claim 29 wherein digital content includes one or more of:

- digitally encoded executable code;
- digitally encoded source code;
- a digitally encoded video program;
- a digitally encoded audio program;
- digitally encoded music;
- a digitally encoded game;
- a digitally encoded multi-media program;
- a digitally encoded movie; and
- a digitally encoded text document.

51. A system for licensing digital content, the system comprising:

- a licensing server
 - that receives and stores license information from a remote digital-content supplier;
 - that generates an electronic license certificate for the digital content; and
 - that provides the electronic license certificate for the digital content to a requesting license component running on a client computer that, upon receiving the electronic license certificate, generates a useable form of the digital content on the client computer from the one or more digital-content components received from the remote digital-content supplier.

52. The system of claim 51 wherein at least one digital-content component is encrypted.

53. The system of claim 51 wherein the license component requests an electronic license certificate from the licensing server.

54. The system of claim 53 wherein, when the license component receives an electronic license certificate from the licensing server, the license component decrypts any encrypted, digital-content components.

55. The system of claim 51 wherein the license component executes a purchase transaction to purchase a license for the digital content on behalf of a user.
56. The system of claim 51 wherein digital-content components may include one or more of:
- an encrypted executable file;
 - an encrypted data file;
 - a user interface library;
 - a purchasing request library;
 - a security information file; and
 - an electronic license certificate.
57. The system of claim 51 wherein digital content includes one or more of:
- digitally encoded executable code;
 - digitally encoded source code;
 - a digitally encoded video program;
 - a digitally encoded audio program;
 - digitally encoded music;
 - a digitally encoded game;
 - a digitally encoded multi-media program;
 - a digitally encoded movie; and
 - a digitally encoded text document.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.